

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-34 are pending in the application. Claims 1, 3, 4, 6-18, and 20-34 have been amended. Claim 2 has been cancelled. Claims 35-54 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendments were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments, in many instances.

Objections to the disclosure

The Examiner has objected to the disclosure for multiple informalities.

In response, the Assignee has amended the specification to correct these informalities.

Objections to the claims

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Claim rejections - 35 USC §112

The Examiner has objected to the specification for failing to provide adequate support for subject matter claimed in claims 12 and 13, and has likewise rejected claims 12 and 13 on the same basis. Specifically, the Examiner objects to there being a failure to describe in the specification how the sensors "generate signals carrying image information of a side of the document." Likewise, the Examiner has rejected claims 12 and 13 stating that "while being enabling for using signals generated by the sensors (230 and 240) to activate the image extraction apparatus (or other apparatuses or device), does not reasonably provide enablement for how the sensors (230 and 240) are in electrical or optical communication with the image extraction apparatus to transmit signals carrying image information of the first and second sides of the document to the image extraction apparatus."

In response, the Assignee has amended claims 12 and 13 to be more clearly supported by the specification. Specifically, claim 12 has been amended to read in part "*wherein the first and*

second sensors are in electrical or optical communication with the image extraction apparatus, and are capable of transmitting a signal to the image extraction apparatus upon detection of the document". Likewise, claim 13 has been amended to read in part "*wherein the image extraction device includes a light source capable of adjusting according to the detection of the document by the first and second sensors*". Assignee submits that the above amended language addresses the Examiner's rejection and is supported by the specification, for example, at paragraph [0033] as follows:

[0033] Upon entering the second-side scanning region 216, similarly, if the second side 226 is not to be scanned in step s310, the sensor 240 is disabled, and the image extraction apparatus 208 is inactivate. The document 222 is then discharged after passing through the second scanning region 216 in step s314. If the second side 226 is to be scanned in step s310, **the sensor 240 is switched on to generate a signal carrying image information of the second side 226 to the image extraction apparatus 208 when the second side 226 of the document 222 is detected. The light source 208a is thus adjusted according to the image information of the second side 226, and the second side 226 is scanned in step s312. After scanning the second side 226 in step s312, the document 222 is discharged from the paper feeder 202 along the direction indicated by the arrow 234 as shown in FIGS. 4A and 4B. (emphasis added)**

Allowable subject matter

The Examiner has indicated that the subject matter of claims 28-31 would be allowable if rewritten to overcome the objections for informalities. Assignee submits that the above amendments have rectified the objections for informalities and that claims 28-31 are now in condition for allowance.

New claims 37, 43-47 and 53-54 are similarly allowable, at least on the same or similar basis as claim 28.

The Examiner has indicated that the subject matter of claims 32-34 would be allowable if rewritten to overcome the objections for informalities. Assignee submits that the above amendments have rectified the objections for informalities and that claims 32-34 are now in condition for allowance.

New claims 35, 36, and 48-52 are similarly not anticipated, at least on the same or similar basis as claim 32.

Similarly, Assignee has amended independent claim 14 to incorporate limitations similar to allowable claim 32. Accordingly, Assignee submits that claim 14 as amended is now in

condition for allowance. Dependent claims 15-22 are similarly allowable, at least on the same or similar basis as claim 14.

Additionally, the Examiner has indicated that the subject matter of dependent claims 2, 3, 7, 11, 15, 20 would be allowable if rewritten in independent form.

In response, Assignee has amended independent claim 1 to incorporate limitations from dependent claim 2 (now cancelled). Accordingly, Assignee submits that claim 1 as amended is now in condition for allowance. Dependent claims 3-13 are similarly allowable, at least on the same or similar basis as claim 1.

Likewise, Assignee has amended independent claim 23 to incorporate subject matter similar to dependent claim 2 (now cancelled). Accordingly, Assignee submits that claim 23 as amended is now in condition for allowance.

Dependent claims 24-27 and new claims 38-42 are similarly allowable, at least on the same or similar basis as claim 23.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503)439-6500 if there remains any issue with allowance.

Additional Fees

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Respectfully submitted,

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